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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/665,365	09/22/2003	Nirupama Karunaratne	056365-5048	4895
9629 7590 01/04/2007 MORGAN LEWIS & BOCKIUS LLP 1111 PENNSYLVANIA AVENUE NW WASHINGTON, DC 20004			EXAMINER JOLLEY, KIRSTEN	
			ART UNIT	PAPER NUMBER
			1762	

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	01/04/2007	PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

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<b>Office Action Summary</b>	<b>Application No.</b> 10/665,365	<b>Applicant(s)</b> KARUNARATNE ET AL.	
	<b>Examiner</b> Kirsten C. Jolley	<b>Art Unit</b> 1762	

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 11 October 2006.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 13-15 and 18-28 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 13-15 and 18-28 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
     Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
     Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date <u>5/20/05, 4/28/04, 9/19/05</u> . | 6) <input type="checkbox"/> Other: _____  |

## DETAILED ACTION

### *Specification*

1. The disclosure is objected to because of the following informalities: Page 7, lines 15-16, of the specification disclose “mica aluminum silicate”. The Examiner questions whether there should be a comma between “mica” and “aluminum silicate.”

Appropriate correction is required.

### *Claim Objections*

2. Claim 13 is objected to because of the following informalities: In claim 13, line 7, the Examiner questions whether there should be a comma between “mica” and “aluminum silicate”.

Appropriate correction is required.

### *Double Patenting*

3. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the “right to exclude” granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned

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with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

4. Claims 13-15 and 18-28 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 41-44 of copending Application No. 11/417,162. Although the conflicting claims are not identical, they are not patentably distinct from each other because it would have been obvious to have included a film-former and a pigment in the pearlescent paint layer of Appln No 11/417,162 because it is well known that film-formers are necessary to form a continuous and well-formed paint film layer and pigments are well known for providing color to paints.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

### ***Claim Rejections - 35 USC § 102***

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

6. Claims 13-14, 18-22, and 26-27 are rejected under 35 U.S.C. 102(b) as being anticipated by Miyatake et al. (US 2002/0043464).

Miyatake et al. discloses a process for producing a pearlescent white coating on a substrate (paragraphs 0071-0076), the coating comprising: a film-former resin component; a hiding material including aluminum flake particulate; a pigment including titanium white which

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mainly contains titanium dioxide; and a pearlizing compound including titanium oxide-coated scaly mica.

As to claim 14, Miyatake et al. teaches applying a clear top coat in paragraph 0078.

As to claim 26, the film-former resin component may include base resins such as acrylic resins, polyester resin, alkyd resin, urethane resin and the like with crosslinking agents such as melamine resin, polyisocyanate compounds and the like.

As to claim 27, the composition has a water/aqueous base.

***Claim Rejections - 35 USC § 103***

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. Claims 23-25 and 28 are rejected under 35 U.S.C. 103(a) as being unpatentable over Miyatake et al.

As to claims 24-25, Miyatake et al. does not disclose the specific amounts of white pigment, aluminum flake and coated mica, in relation to one another, to be used in its coating composition. It would have been obvious for one having ordinary skill in the art to have determined the optimum combination of pigment, hiding material, and pearlizing compounds in a particular paint as a matter of design preference depending on the desired properties (reflectivity, color, brightness, etc.) of the product.

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As to claim 23, the use of silica-coated aluminum flake as luster pigments is known in the art of paint coating in order to produce different optical coating effects. It would have been obvious to have substituted silica-coated aluminum flake for uncoated aluminum flake in the process of Miyatake et al. with the expectation of producing different optical coating/light effects.

As to claim 28, Miyatake et al. discloses use of acrylic, urethane, and melamine resins in paragraph 0072 as discussed above. Miyatake et al. is not limited as to the particular combination and amounts of the resins used to form its base coat (b). It would have been obvious to one having ordinary skill in the art to have determined an optimum coating formulation using the resins taught by Miyatake et al. through routine experimentation depending upon the desired properties of the end coating.

9. Claims 13-15 and 18-28 are rejected under 35 U.S.C. 103(a) as being unpatentable over Fowler et al. (US 4,978,708).

Fowler et al. discloses applying a paint composition comprising a film former, and solids material comprising pigments, and reflective particulate agents to provide an enhanced "metallic veneer" effect including metallic aluminum flake (a hiding material) and particulate micas (a pearlizing compound) (col. 13, line 47 to col. 14, line 12), and curing the composition on the substrate. While Fowler et al. does not specifically teach that the pigments are to be used in combination with the reflective particulates, it is the Examiner's position that it would have been obvious to one of ordinary skill in the art to have used pigments and reflective agents in combination because it is well known that metallic type automobile coatings are often colored as

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well, and because Fowler et al. is suggestive of each separately and in combination. Further, it is noted that mica in a paint composition may be considered both a hiding material and pearlizing compound.

As to claim 14, Fowler et al. teaches that a clear coat may be applied over its basecoat composition (col. 16, lines 47-48).

As to claim 15, Fowler et al. teaches use as an automotive coating in col. 1, line 15.

As to claims 18-19, Fowler et al. teaches use of titanium dioxide pigment, as well as zinc oxide or zinc sulfide, which are white.

As to claim 23, the use of silica-coated aluminum flake as luster pigments is known in the art of paint coating in order to produce different optical coating effects. It would have been obvious to have substituted silica-coated aluminum flake for uncoated aluminum flake in the process of Fowler et al. with the expectation of producing different optical coating/light effects.

As to claims 24-25, Fowler et al. is silent with respect to the specific amounts of pigment, hiding material, and pearlizing compounds that make up the solids material. It would have been obvious for one having ordinary skill in the art to have determined the optimum combination of pigment, hiding material, and pearlizing compounds in a particular paint as a matter of design preference depending on the desired properties (reflectivity, color, brightness, etc.) of the product.

As to claim 26, Fowler et al. teaches that the film-former comprises a polyurethane principal resin (see Abstract).

As to claim 27, Fowler et al. is directed to an aqueous-based composition.

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As to claim 28, Fowler et al. does not disclose the specific composition claimed, however Fowler et al. discloses that a number of other resins may be included in its formulation, including acrylic copolymer and polyester (col. 11-12). It would have been obvious to one having ordinary skill in the art to have determined an optimum coating formulation through routine experimentation depending upon the particular end use of the coating and its desired properties.

### ***Conclusion***

10. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Schmid et al. (US 5,607,504) is cited for its teaching of silicon oxide-coated aluminum flake as luster pigments useful in coating compositions.

ZA 94505 is cited for its teaching of a coating mixture on pages 3-5 containing in the solids material white pearlescent pigment, aluminum pigment, and white pigment.

11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kirsten C. Jolley whose telephone number is 571-272-1421. The examiner can normally be reached on Monday to Wednesday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Timothy Meeks can be reached on 571-272-1423. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.



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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



Kirsten C Jolley  
Primary Examiner  
Art Unit 1762

kcj